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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,520	12/07/2000	John Roderick Morrison	14390	1130

7590 02/18/2004

Attn: Leopold Presser, Esq.
Scully, Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,520

Applicant(s)

MORRISON ET AL.

Examiner

Anne-Marie Falk, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-62 and 67-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-62 and 67-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment filed December 15, 2003 has been entered. Claims 1-21, 33-44, and 63-66 have been cancelled. Claims 67-70 have been newly added.

Accordingly, Claims 45-62 and 67-70 are pending in the instant application.

The following rejections are reiterated and constitute the complete set of rejections being applied to the instant application. Rejections and objections not reiterated from the previous office action are hereby withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2003 has been entered.

~~*Claim Rejections - 35 USC § 112*~~

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 45-62 stand rejected and Claims 67-70 are rejected under 35 U.S.C. 112, first paragraph, for reasons of record advanced on pages 4-7 of the Office Action of Paper No. 13 (mailed 8/9/02) as applied to Claims 22-32, and pages 3-6 of the Office Action mailed 5/12/03, as containing subject matter

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are directed to (i) a method of producing a non-human embryo by nuclear transfer, using a neural stem cell as the source of the donor nucleus, (ii) a method of producing a genetically modified non-human animal by nuclear transfer, and (iii) a method of producing a cell line from an embryo to produce cloned cells of an embryo.

With regard to the enablement rejection, Applicants argue that Westhusin et al. do not teach that there is any major difference in nuclear transfer steps in a cloning procedure. Applicants argue that the basic approach involving nuclear transfer is similar and includes six steps in all animal species. Applicants further argue that the techniques that are required to accomplish each of these steps vary slightly between species. However, these slight variations markedly affect the success or failure of the cloning protocol. There are no general guidelines for determining which modifications, no matter how large or small, are required to come up with a successful cloning protocol for a new species. Westhusin et al. emphasizes that “[w]hile the basic approach involving nuclear transfer may be similar, the specific materials and methods utilized for cloning one species of animal do not automatically apply across different species” (page 36, paragraph 4). Westhusin et al. further points out that “[c]loning a particular animal in order to reproduce a specific genotype can be an extremely challenging venture” (page 36, paragraph 3). The references cited in the previous Office Actions demonstrate that the field of somatic cell nuclear transfer as a whole is still in its infancy. The technical steps of nuclear transfer are complex, and minor variations in any of a number of parameters can easily impede success.

The Declaration has been fully considered but is not found to be persuasive. The instant specification does not teach how to use an embryo for anything other than producing a **cloned animal**. The Declaration of Dr. Morrison shows that **culture *in vitro*** to the morula/blastocyst stage is required (in

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rat, mouse, and cow), but the **claims** do not require *in vitro* culture to the morula/blastocyst stage.

Furthermore, the culture criteria for other species has not been established.

At page 7 of the response, Applicants argue that Hirabayashi et al. (2003) teaches that the difficulty in adapting nuclear transfer procedure to the rat is due to the spontaneous activation of the rat oocyte *in vitro*, which reduces the efficiency with which donor nuclei can be reprogrammed and the subsequent development to the morula/blastocyst. However, since Hirabayashi is **post-filing art**, the skilled artisan would not have had the benefit of its teachings in Dec. 2000, the filing date of this application.

Thus, the enablement rejection is maintained.

Conclusion

No claims are allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Thursday and alternate Fridays from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to William Phillips, whose telephone number is (571) 272-0548.

Anne-Marie Falk, Ph.D.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER